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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,900	02/10/2006	Hidetaka Kojima	3273-0219PUS1	2123
2292 7590 12/18/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER LAO, MARIALOUISA	
			ART UNIT 1621	PAPER NUMBER
			NOTIFICATION DATE 12/18/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/567,900	KOJIMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	M. Louisa Lao	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/26/07 has been entered.

### ***Response to Arguments***

2. Applicant's arguments, see REMARKS, filed 11/19/07, with respect to issues under 35 U.S.C. 103(a) have been fully considered and are persuasive. The rejection of claims 1-10 and the finality of the Office Action mailed 8/17/07 have been withdrawn.

3. However, upon further consideration, a new ground(s) of rejection is made, see below.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung et al. (US7005541, US'541) in view of Miura et al. (EP0687662, EP'662).

6. The instant claims are drawn to a method for producing acetic acid, comprising, *inter alia*, continuously reacting methanol with carbon monoxide in the presence of a rhodium catalyst, an iodide salt, methyl iodide, methyl acetate, and water; with the following method characteristics, which are, *inter alia*, a production rate of 11 mol/L.hr or more; the acetaldehyde content kept to 500 ppm or less, carbon monoxide partial pressure of 1.05 MPa or more, methyl acetate of reaction mixture of 2 percent by weight or more, production rate of acetaldehyde to production rate of acetic acid at 1/1500 or less, hydrogen partial pressure, *inter alia*, at 100kPa or less, water content of the reaction mixture of 3% by weight or less. The instant claims include a purification process. The said purification step comprises the separation of the target acetic acid compound from the reaction by-products, treating the acetic acid with a silver- or mercury-

exchanged *[sic]* resin, as well as the recovery and recycling of catalyst system and reactants reusable to augment virgin materials.

7. US'541 in column 6 lines 1- 67 continuing to columns 7-8 lines 1 68 teaches that in the carbonylation reaction to form acetic acid, the reaction mixture of methanol and carbon monoxide is continuously fed to a reactor in which desired partial pressure of carbon monoxide is maintained, the accumulation and level of impurities or PRC's (permanganate reducing components, like acetaldehyde) are kept to a minimum; whereby the reaction mixture is separated into product acetic acid and lighter components of reaction mixture, the latter containing mostly acetic acid and catalyst may be recycled back to the reactor. Vapors from the flasher are fed to a splitter, where overhead vapors are condensed and separated into light aqueous phase and a heavy organic phase. The light aqueous phase contains water, acetic acid, methanol, methyl iodide and methyl acetate and some PRC's. The heavy organic phase contains mainly methyl iodide and methyl acetate, which may be recycled as is or after further processing. The light aqueous phase is typically used as reflux and a portion recycled back to the reaction section, where typically a first distillation column serves to separate the fraction of a lighter overhead comprising acetaldehyde, methyl iodide and methyl acetate from the heavier fraction comprising acetic acid and water which is recycled to the purification section. In lines 41-68 column 7, US'541 delineates the steps and components thereto, comprising *volatile and low-volatile components separated by at least two distillation steps, the volatile component comprising acetic acid, water, methyl acetate and methyl iodide, and the low-volatile component comprising the catalyst system and the PRC's (carbonyl impurities)* by step-wise illustration of the figure therein inclusive of the *distillation columns* and reference to *further processing steps*.



US`541 teaches the acetic production rates of 15 g-mol/l/hr of less than 2.0% water, using rhodium or rhodium/iridium catalysts with methyl acetate (column 4 lines 48-53); where the methyl acetate levels are 1.0-30% (column 6 lines 18-23). US`541 teaches the continuous carbonylation process to comprise reaction, purification, and off-gas treatment sections (column 7 lines 41-43).

8. The instant claims differ from US`541 in that US`541 does not explicitly teach the amount of acetaldehyde and the partial pressure of carbon monoxide.

9. However, EP`662 recites in page 20 claims 1-2, a process of producing a high purity acetic acid, comprising continuously reacting methanol with carbon monoxide in the presence of a rhodium catalyst, an iodide salt, and methyl iodide, wherein the reaction is carried out while maintaining *an acetaldehyde concentration* in the reaction liquid at 400 ppm or lower. In page 4 lines 37-39, EP`662 states that the water content is preferably 1 to 5 weight %. In page 4 lines 45-46, EP`662 states the partial pressure of carbon monoxide is preferably 4 to 15 atm. In lines 53-57 page 3, EP`662 discusses that the resulting reaction liquid of methanol with carbon monoxide in the presence of a rhodium catalyst, an iodide salt and methyl iodide is *separated* from the low volatile phase containing the rhodium catalyst, *distilling* the volatile phase to obtain a product mixture containing acetic acid and the overhead containing methyl acetate and methyl iodide, and *recirculating* said overhead into the reactor, wherein the overhead contains acetaldehyde and iodide. In page 2 lines 49-51, EP`662 discusses that the *ion-exchange resin* for treating the acetic acid is the partially converted *silver* form of a macro-reticulated strong acid cation exchange resin.

10. At the time of Applicants' invention was made, it would have been obvious to a person of ordinary skill in the art to utilize the process steps of US'541 with EP'662 since the carbonylation process of US'541 has the equivalent components of acetic acid, water, methyl acetate and methyl iodide, and catalyst system, inclusive of undesirable PRC's and other impurities.

11. One having ordinary skill in the art would have been motivated utilize the process steps of US'541 with EP'662 since the carbonylation of US'541 for acetic acid shows the components are separated efficaciously with an increased STY (space time yield) with impurities kept to the minimum, which is an equivalent carbonylation process of EP'662 for the production of acetic acid and the artisan in optimizing his processes within the normal routine of adapting processes that work effectively, would expect a reasonable expectation of producing acetic acid.

12. The combination of the teachings of US'541 and EP'662 are fairly suggestive of the *prima facie* obviousness of the instant claims, as recited.

In applying known technique to a known device (method, or product) ready for improvement to yield predictable results, the claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art.

The claim would have been obvious because "a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product, not of innovation, but of ordinary skill and common sense.

13. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung et al. (US7005541, US'541) in view of Miura et al. (EP0687662, EP'662) as applied to claims 1 and 5-10 above, and further in view of Key et al. (US6472558, US'558).

14. The instant claims are drawn to a method for producing acetic acid, comprising, *inter alia*, continuously reacting methanol with carbon monoxide in the presence of a rhodium

catalyst, an iodide salt, methyl iodide, methyl acetate, and water; with the following method characteristics, which are, *inter alia*, a production rate of 11 mol/L.hr or more; the acetaldehyde content kept to 500 ppm or less, carbon monoxide partial pressure of 1.05 MPa or more, methyl acetate of reaction mixture of 2 percent by weight or more, production rate of acetaldehyde to production rate of acetic acid at 1/1500 or less, hydrogen partial pressure at 100kPa or less, water content of the reaction mixture of 3% by weight or less; and a purification process. The said purification step comprises the separation of the target acetic acid compound from the reaction by-products, treating the acetic acid with a silver- or mercury-exchanged [*sic*] resin, as well as the recovery and recycling of catalyst system and reactants reusable to augment virgin materials.

15. US'541 in view of EP'662 are discussed as set forth above and included herein in their entirety.

16. The instant claims differ from US'541 and EP'662 in that the latter two do not explicitly teach the partial pressure of hydrogen.

17. However, US'558 teaches that in the process for the production of acetic acid by reacting carbon monoxide with methanol in the presence of an iridium catalyst, there is the presence of hydrogen in the carbon monoxide feed, where the partial pressure of hydrogen is preferably less than  $1 \times 10^5 \text{ N/m}^2$  and the partial pressure of carbon monoxide is in the range  $1 \times 10^5 \text{ N/m}^2$  to  $7 \times 10^6 \text{ N/m}^2$  (column 6 lines 5-19). US'558 teaches the water concentration is in the range of 1-15 wt % (column 5 lines 13-14).

18. At the time that Applicants' invention was made, it would have been obvious to one having ordinary skill to reconcile the use of the teachings of partial pressure of hydrogen of



US`558 in the method of US`541 and EP`662 since the process of US`558 is a carbonylation process for the production of a carboxylic acid entailing the use of carbon monoxide and an alkyl alcohol, in the presence of a carbonylation catalyst; whereby similarly, US`541 and EP`662 are drawn to a carbonylation process of acetic acid, which includes the reaction of carbon monoxide with methanol in the presence of a rhodium catalyst, an iodide salt, and methyl iodide. The carbonylation process of US`558 is equivalent to US`541 and EP`662, and similarly, acetic acid is a typical carboxylic acid effectuated from the reaction of carbon monoxide with methanol, where the latter is a typical alkyl alcohol and the production rate in US`558 would have been equivalent to that achieved for US`541 and EP`662; since additionally, US`541 and EP`662 also solved the problem of 400ppm less carbonyl impurities, like acetaldehyde.

19. One having ordinary skill in the art would have been motivated to combine the teachings of US`558 in US`541 and EP`662, since US`558 has shown the advantage of partial pressure of carbon monoxide to the partial pressure of hydrogen result to a faster and more efficacious carbonylation process for the formation of acetic acid; whereby the artisan in adapting optimal methods and parameters that have been found to be effective in his art, would then expect a reasonable expectation of producing acetic acid.

20. Absent a showing of unexpected results, the recitation of values for partial pressure of hydrogen in consonance with the recited process conditions, are optimization steps that are within the normal undertaking of one of ordinary skill in the art at the time of the invention and would not require any inordinate degree of experimentation.

Optimizing such processes is *prima facie* obvious because an ordinary artisan would be motivated to use known processes from the art to make the process more efficient or explore economical advantages over the other. Merely modifying the process conditions is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 105 U.S.P.Q. 233 (C.C.P.A. 1955).

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The claim would have been obvious because "a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product, not of innovation, but of ordinary skill and common sense.

21. There are no allowable claims.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MLouisa Lao whose telephone number is 571-272-9930. The examiner can normally be reached on Mondays to Thursdays from 8:00am to 8:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

`mll12052007  
MLouisa Lao  
Examiner  
Art Unit 1621

*for*   
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TC1600 GAU 1621